

Notice of Allowability

Application No.

09/370,358

Examiner

Michael Brannock

Applicant(s)

SKLAR ET AL.

Art Unit

1649

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the BPAI decision of 4/27/05.
2. ☒ The allowed claim(s) is/are 1-17,23,48,51,53 and 54.
3. ☒ The drawings filed on 21 August 2002 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted:
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Henry Coleman on July 18, 2005.

The application has been amended as follows:

Please cancel claims 24-47

EA

The following is an examiner's statement of reasons for allowance:

The rejection of claims 1, 6, 9-13, 15-17, 48, 50, 51, and 53-57 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No: 5583010 in view of U.S. Patent No: 5639603 is withdrawn in view of the Board of Patent Appeals and Interferences decision (Appeal No. 2004-1728), particularly that the combination of Baumbach and Dowry do not suggest analyzing receptor interactions in real-time as required by the instant claims as Dower's wash step illustrates that the receptor-ligand binding step is separated in time from the analysis step, see the last paragraph of page 6 following to page 7 of Appeal No. 2004-1728.

The rejection of claims 2, 3-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No: 5583010, in view of U.S. Patent No: 5639603 as applied to

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claims 1, 6, 9-13, 15-17, 48, 50, 51, and 53-57 above, and in further view of Robeva, AS *et al.*, *Drug Development Research* 39(243-252)1996 is withdrawn in view of the Board of Patent Appeals and Interferences decision (Appeal No. 2004-1728), that the combination of Baumbach and Dowry do not suggest analyzing receptor interactions in real-time as required by the instant claims.

Linking claim 1 is allowed. Since the restriction requirement between inventions is, as set forth in the Office action mailed on 11/30/00, was conditioned on the nonallowance of the linking claim(s), **the species restriction requirement as to the linked inventions is hereby withdrawn.** Claim 14, previously withdrawn from consideration as a result of the restriction requirement, is hereby rejoined and fully examined for patentability under 37 CFR 1.104. In view of the withdrawal of the restriction requirement as to the linked inventions, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01. Additionally, the examiner has determined that claim 23, previously withdrawn from consideration as a result of the restriction requirement of 11/30/00, more properly belonged to the elected group and is hereby rejoined and fully examined for patentability under 37 CFR 1.104.

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Additional Reference of Relevance:

Sarvazyan-NA et al., *Biochemistry* 41(12858-12867)2002 disclose a method of noncellular analysis and display of 7-transmembrane receptors (α_{2A} AR receptor) comprising the following steps:

- a) incorporation of an attachment tether to the receptor (HA epitope)
- b) presenting the receptor in conjunction with a support (avidin coated beads)
- c) presenting at least one ligand to bind the receptor ($F\text{-}\alpha_{II}$), see line 5 of the Abstract,
- d) combining the receptor and ligand to accomplish binding while the receptor is bound to the support (see col 1 of 12860, *Flow Cytometric Analysis of Equilibrium $F\text{-}\alpha_{II}$ Binding*)
- e) washing the bound receptor/ligand pairs (see col 1 of 12860, *Flow Cytometric Analysis of Equilibrium $F\text{-}\alpha_{II}$ Binding*)
- f) sorting the bound receptor-ligand pairs by fluorescence and using flow cytometry to analyze the fluorescence and binding interactions in real time (see the last sentence of the Abstract and col 1 of 12860).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Conclusion

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1649.

Please note the new central fax number for official correspondence below:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (571) 272-0869. The examiner can normally be reached on Mondays through Fridays from 10:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, Ph.D., can be reached at (571) 272-0867. Official papers filed by fax should be directed to **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MB

Elizabeth C. Kemmerer

July 26, 2005

**ELIZABETH KEMMERER
PRIMARY EXAMINER**